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10/829,640

04/22/2004

James E. Swon

04-02 US

7024

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10/04/2006

Varian Inc.

Legal Department

3120 Hansen Way D-102

Palo Alto, CA 94304

EXAMINER

HANDY, DWAYNE K

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/829,640

Applicant(s)

SWON ET AL.

Examiner

Dwayne K. Handy

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/22/04, 8/2/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claims 12-14 and 31-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 12-14 and 31-34 recite a "pick up component". This term is unclear. What structural elements for this component are required to meet the limitation of a "pick up component"?

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, 7-11, 15, 16 and 18-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Shah et al. (3,801,280). Shah teaches a dissolution test apparatus and method. The apparatus includes a container (1) having a lid (4) having a sample holder (2) and filter element (8) connected to it. The filter element contains a magnet (16) on the inside that is driven by a magnet (46) outside the container.

4. Claims 1-11, 15-17, 21-30 and 35-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Zuellig et al. (6,126,904). Zuellig teaches an apparatus and method for the preparation of chemical compounds. The device is best shown in Figures 1B, 2, 14, 18 and 19. As shown in the Figures, the device includes a plurality of reaction vessels (30) having a first opening (41) connected to feed fines (50, 60) through a fitting and a second opening (42) in the bottom. The vessels include an actuated agitator (35) in the form of a magnetic plunger, stir bar, bar, bead, column or disk that is driven by a magnet (500) provided next to the vessels (column 7, line 60 – column 8, line 22).

The Examiner notes that Applicant has broadly claimed a movable component and sample carrier elements. The Examiner considers the magnet element (35) as meeting the limitation of a movable component since it may be moved by other magnetic elements. The Examiner considers the solid support elements recited by Zuellig (column 5, lines 16-32) as meeting the limitation of a sample carrier that releases compounds. Applicant has also recited a first and second sections in a container, but these claimed sections do not have any physical limitations. Therefore, any container may have multiple sections.

5. Claims 1-4, 7-11, 15, 16 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Nielsen (6,582,116). Nielsen teaches an apparatus for mixing small volumes of reaction materials. The device is best shown in Figures 1, 2, and 8. It

includes a reactor (301) having a movable component (3/351) driven by an element (71/351) coupled to a driver via a magnetic coupling (353). The magnetic coupling is in the cover (361) that closes the reactor.

The Examiner notes that Applicant has broadly claimed first and second sections in a container, but these claimed sections do not have any physical limitations. Therefore, any container may have multiple sections and meet this limitation.

6. Claims 1-4, 7-11, 15, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Jahn et al. (7,074,364). Jahn teaches a device and method for carrying out reactions in parallel. The device is best shown in Figures 1, 2 and 7. The device includes reactors (12) having lids (21-29) for covering the reactors (12). Each reactor may be mixed by a magnetic driver (4) that is coupled to a magnetic element inside the reactor.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. MacMichael et al. (4,759,635), Conant et al. (5,215,717), Christian et al. (5,267,791), and Chandler, Jr. (6,692,708) teach containers having stirrers driven by magnetic drivers.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DKH  
September 30, 2006

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700